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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/986,190 | 11/07/2001 | Takayuki Nimiya | OGW-0203 | 4895 |

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| EXAMINER | |
|---|---|
| WATSON, ROBERT C | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3723 | |

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/986,190 | Applicant(s) NIMIYA ET AL. | |
|---|---|---|---|
| | Examiner Robert C. Watson | Art Unit 3723 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Peri d for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 October 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) *1, 4;1, and 6;1* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2,3,4;2,4;3,5,6;2 and 6;3* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Applicants' remarks concerning the restriction requirement have been given careful consideration. It is the examiner's position that the invention of Group I (claims 1, 4;1, and 6;1) is directed to a single invention, namely, a process of making an overhead infrastructure. The remaining claims, namely, Group II (claims 2,3, 4;2,4;3,5, 6;2, and 6;3) are directed to an ambiguous invention(s) that, insofar as the examiner can understand, predominately is directed to a process of using an overhead infrastructure to do business. Applicant has elected the invention of Group II. Applicants' argument is that since the invention of Group II includes both the invention of making an overhead infrastructure and the invention of using an overhead infrastructure that Groups I and II are not patentably distinct. Applicant's argument is believed to be untenable inasmuch as 35USC101 only allows applicants to claim a single invention in a single claim and not plural inventions in a single claim. Applicants further argue that the search of the invention of Group I and the search for the invention of Group II would not be a serious burden to the Office. This position is found to be untenable. The search for the invention of Group I does not require a search into the business methods class while the search of Group II does requires such a search. Because the searches are not co-extensive there would be a serious burden placed on the Office to search both inventions. The restriction requirement is therefor deemed proper and is hereby made FINAL.

Note: applicants should present the elected claims of Group II in independent form to to avoid confusion with respect to the claims of Group I.

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2, 3, 4;2, 4;3, 5, 6;2, and 6;3 are rejected under 35 U.S.C. 101 because applicant has claimed plural categories of invention in a single claim. The statute's language proscribes that "invention" is in the singular and not the plural. It is noted that applicants in paper no. 4 make the admission that these claims are "including both of a process of making and a process of using an overhead infrastructure". Applicant's attempt to claim plural inventions in a single claim is unstatutory.

Claims 2, 3, 4;2, 4;3, 5, 6;2, and 6;3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. One skilled in the art, armed with the present specification, would be unable to "manage the business conductors", "provide for rent or sale with a fee according to a number and weight of the overhead lines", or "set a size of the overhead cableway based on estimated damand". There are no specific formulas presented in the specification to arrive at these calculations and one skilled in the art would have to perform undue experimentation to achieve these recited results.

Claim 2, 3, 4;2, 4;3, 5, 6;2, and 6;3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims appear to be directed to more than one invention. As such, the metes and bounds of these claims

are indeterminate of scope. Moreover, the claims are replete with vague and indefinite terms; eg., "managed", "business conductors", "administrator", "rights". What kind of entity is a business conductor? Is it a person, a corporation, or is it the cable that conducts electricity? No new matter will be allowed to be entered in this case.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 3, 4;2, 4;3, 5, 6;2, and 6;3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chikiri et al in view of Kuenzi.

Figure 2 of Chikiri et al shows an elongate coil 8 having a resin coating that has been inserted outside around a tensile line 2. Chikiri does not specifically mention the process of "plastic deformation of the coil". However, it is obvious that plastic deformation must have taken place to form the coil shown in Figure 3A of Chikiri. Chikiri et al states that the coil is elongated by being "bent" (Chikiri, column 3, line 52). This is considered to be a process that obviously plastically deforms the coil. In Chikiri et al the coil was elongated prior to being inserted outside around the tensile line. However, claim 1 does not specify the time that the coil is elongated. Claim 5 would read on the coil being elongated at the time of manufacture of the elongated coil. The size of the coil both before and after the elongation is no more than an obvious matter of design choice absent a showing of criticality for this feature. Chikiri et al only discloses that a single cable is being pulled in the installation process.

Kuenzi teaches a process whereby a device, 5, is used in the installation process such that more than one cable can be installed in one pulling process.
To employ a device on the pulling line of Chikiri et al so as to simultaneously pull, on demand, any number of cables simultaneously would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Kuenzi. One of ordinary skill in the art would have been motivated to do this in order to more efficiently install more than one cable on the overhead infrastructrure. It is axiomatic for one skilled in the art, that the pull line must have the requisite tensile strength to pull the total number of cables being pulled otherwise the pull line will break. Accordingly, one skilled in the art would be armed with basis statics and strength of materials knowledge and that one skilled in the art would undoubtedly make sure that the pull line has the requisite strength taking into account all factors such as the size, weight, length, number of cables, and the drag on the cables from the reels they are being dispensed from. Insofar as the claims can be understood, one skilled in the art would know that the number of cables, size of cable, and length of cables will be dictated from the "damand" for such cables. It would have been obvious for one skilled in the art to select the number of cables, size of cable, and length of cable commensurate with the "demand" for such cabling. It would further have been obvious for one skilled in the art to make such selections based on the projected "sale" or "rent" projections; ie, it is

obvious that a profit has to be achieved and selections will be obviously made commensurate with the desire to achive such a profit.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over any of claims 1-8 of U.S. Patent No. 6,505,818 in view of Kuenzi.

The claims of U.S. Patent No. 6,505,818 teach the installation of a single cable on an overhead infrastructure.

Kuenzi teaches a process whereby a device, 5, is used in the installation process such that more than one cable can be installed in one pulling process.

To employ a device on the pulling line of the invention set forth in claims of U.S. Patent No. 6,505,818 so as to simultaneously pull, on demand, any number of cables simultaneously would have been obvious for one skilled in the art at the time the invention was made in view of the disclosure of Kuenzi. One of ordinary skill in the art would have been motivated to do this in order to more efficiently install more than one

cable on the overhead infrastructrure. It is axiomatic for one skilled in the art, that the pull line must have the requisite tensile strength to pull the total number of cables being pulled otherwise the pull line will break. Accordingly, one skilled in the art would be armed with basis statics and strength of materials knowledge and that one skilled in the art would undoubtedly make sure that the pull line has the requisite strength taking into account all factors such as the size, weight, length, number of cables, and the drag on the cables from the reels they are being dispensed from. Insofar as the claims can be understood, one skilled in the art would know that the number of cables, size of cable, and length of cables will be dictated from the "damand" for such cables. It would have been obvious for one skilled in the art to select the number of cables, size of cable, and length of cable commensurate with the "demand" for such cabling. It would further have been obvious for one skilled in the art to make such selections based on the projected "sale" or "rent" projections; ie, it is obvious that a profit has to be achieved and selections will be obviously made commensurate with the desire to achive such a profit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Watson whose telephone number is 703 308-1747. The examiner can normally be reached on Mon. - Thurs. , 5:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail III can be reached on 703 308-2687. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1148.

rcw

ROBERT C. WATSON
PRIMARY EXAMINER